

DETAILED ACTION

Election/Restrictions

Applicant's election of the species of Example 17 in the reply filed on March 12, 2008 and in the reply filed on October 20, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant asserts the species reads on claims 1, 2, 5, 7-9, 11-14, 16, 17, 20, 22, 24, 26-29, 31-36 and new claims 37, 38, 40-42 and 44-52.

Claims 1-36 and new claims 37-52 are pending. Claims 3, 4, 6, 10, 15, 18, 19, 21, 23, 25, 30, 39 and 43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 12, 2008 and October 20, 2008.

Specification

The specification is not in compliance with 37 CFR § 1.58 (a) which states, "The specification, including the claims, may contain chemical and mathematical formulae, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables, but the same tables may only be included in both the drawings and description portion of the specification if the application was filed under 35 U.S.C. 371. Claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable."

Specifically, pages 31-51 of the instant disclosure include schemes.

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As such, Applicant is required to furnish a drawing under 37 CFR § 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 5, 7-9, 11-14, 16, 17, 20, 22, 24, 26-29, 31-38, 40-42 and 44-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 16 recite a variable Y in the formula, however there is no definition for Y in the claim. Thus, it is unclear what is intended by the recitation of Y.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 7-9, 11-14, 16, 20, 22, 24, 26-29, 33-38, 40-42 and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 16 fail to define the variable position Y, thus one cannot describe the compound or any member of genus therein as the chemical structure is incomplete.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5, 7-9, 11-14, 16, 17, 20, 22, 24, 26-29, 31-38, 40-42 and 44-52 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-49 and 57-72 of U.S. Patent No. 7,084,245 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds and compositions of '245 anticipate, or render obvious, the instant claims. For example, the species of claim 72 is the elected species where the PEG is between 10k and 60k. In looking to the specification for the species that provide descriptive support for the claims, one finds the PEG to be 20k (columns 135 and 136), as in the elected species. It is noted that a certificate of correction has been granted cancelling claims 50-56, and thus are not included in the rejection above.

Claims 1, 2, 5, 7-9, 11-14, 16, 17, 20, 22, 24, 26-29, 31-38, 40-42 and 44-52 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 7,414,105 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds and compositions of '105 anticipate, or render obvious, the instant claims. For example, the species of claim 3 is the elected species where the PEG is between 10k and 60k. In looking to the specification for the species that provide descriptive support for the claims, one finds the PEG to be 20k (columns 135 and 136), as in the elected species.

Claims 1, 2, 5, 7-9, 11-14, 16, 17, 20, 22, 24, 26-29, 31-38, 40-42 and 44-52 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 15-34 of U.S. Patent No. 7,528,104 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds and compositions of '104 anticipate, or render obvious, the instant claims. For example, the linker of claim 24 is a species/subgenus of instant claim 2 and the linker of claim 19 is a genus embracing the species of instant claim 49, where one could envisage the instantly claimed species. In looking to the specification for the species that provide descriptive support for the claims, one finds a plurality of compounds that are within the confines of the instant claims, e.g. Table 3 and 4 compounds.

Claims 1, 2, 5, 7-9, 11-14, 16, 17, 20, 22, 24, 26-29, 31-38, 40-42 and 44-52 are directed to an invention not patentably distinct from claims 1-49 and 57-72 of U.S. Patent No. 7,084,245 B2, claims 1-13 of U.S. Patent No. 7,414,105 B2 and claims 15-34 of U.S. Patent No. 7,528,104 B2 for the reasons set forth above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned '245, '105 and '104, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW D. KOSAR whose telephone number is (571)272-0913. The examiner can normally be reached on Monday - Friday 08:00 - 16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia J. Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew D Kosar/
Primary Examiner, Art Unit 1654